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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,516	12/30/1998	DENNIS M. O'CONNOR	INTL-0134-US	1486

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EXAMINER

NGUYEN, HUY THANH

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/223,516

Applicant(s)

O'CONNOR ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15 and 28-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15 and 28-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 28-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (5,526,130).

Regarding claims 28-38, Kim teaches a method for transmission video signal from a broadcast station : transmitting a video transmission together with a coded command (start recording time and end recording time codes). The start recording time and end recording time in vertical blanking interval of the video transmission disclosed by Kim is considered as a command signal because they used for control the recording and en recording of a video recorder ((Figs 1,7,8, column 5, lines 55-60) column 6, lines 57 to column 7, line 10, column 8, line 65 to column 9,lines 25).

Kim further teaches a video receiver comprising: a first device to receive a transmitted video signal and recording command signal included in the vide signal; a second device coupled to said first device to detect a characteristic of the signal in the vertical blanking interval; and a video recorder that records said video signal in response to the detection of said characteristic . Further, Kim teaches the video

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transmission received from a broadcast station that include a replay such as prerecorded movies reproduced from a medium.

3. Claims 11, 15 and 28-38 are rejected under 35 U.S.C. 102(e) as being anticipated Yamamura (5,784,522).

Regarding claims 11, 15 and 28-38, Yamamura discloses a method comprising: transmitting a video transmission together with a coded command to begin recording of the video transmission (Abstract, Fig. 1, column 8) and means of a video receiver for detecting the coded command signal in the video transmission to control a recorder for recording the video transmission (column 7, lines 20-25, column 10).

Regarding claim 31, Yamamura further teaches that the article further storing instructions that enable the system to automatically transmit a digital signal indicating that recording should begin (columns 3-4, 8 and 10).

Further for claims 32-36, it is noted that Yamamura teaches that the video transmission from the transmitter is reproduced from a recording medium. Therefore the video transmission considered as a replay of prerecorded video.

Further for claim 37, Yamamura further teaches that command information is detected in a closed caption transmission since it is known that the vertical blanking intervals of the video signal is used for carrying closed caption.

4. Claims 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated Akira (JP 61-017241 A).

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Regarding claims 28-30 , Akira discloses a method comprising: transmitting a video transmission together with a coded command to begin recording of the video transmission (Abstract, Figs. 1-2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 11-15 and 20-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Woo (5,485,219) in view of Camas (4,097,93).

Regarding claims 11-12, 14-15 and 28-38, Woo discloses a transmitter (Fig. 1)

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and a receiver, the transmitter comprising: a monitor that monitors an ongoing video transmission and provides an indication when a characteristic is detected; and a transmission device that transmits said video transmission together with said indication, wherein said transmission device is an over the air broadcast television transmitter (Fig. 1, Abstract) or cable television transmitter transmission (column 3, lines 30-35, line 41 to column 4, line 15) and the receiver comprises a medium for storing instructions that cause a computer to monitor an ongoing video transmission for a predetermined characteristic; and upon detecting said characteristic, automatically record said video transmission by a recorder while said video transmission is being displayed (column 5, line 27 to column 8, line 17, columns 10 and 11).

Further, it is noted that the ongoing video transmission is monitored by a operator when a replay occurred the operator will operate the system to generated a start recording command to control a recorder to record a replay.

Woo fails to specifically teaches that the recording command is transmitted together with video transmission. However, it is noted that transmitting a start command signal together with a video transmission is well known in the art as taught by Camras. Camras at column 3, lines 30-35 teaches means for generating a command signal to start recording of a recorder, the recording command signal can be transmitted separate from video transmission or together with the video transmission .. It would have been obvious to one of ordinary skill in the art to modify Woo with Camas by using a inserting means as taught by Comas for transmission the recording command along with the video transmission by inserting the recording command in a

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vertical blanking intervals that use for carrying closed captioned of the video transmission , as an alternative method for transmitting the recording command signal of Woo, for transmitting the recording command along with the video transmission.

Regarding claim 13, Woo fails to specifically teach that the video transmission is from a satellite transmitter. However, it is noted that using a satellite transmitter for transmitting video signal is well known in the art Therefore, it would have been obvious to one of ordinary skill in the art to modify Woo by using a satellite transmitter for transmitting video transmission.

7. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamura in view of Official Notice .

Regarding claims 12-14 Yamamura fails to specifically teaches that the transmitter is a television cable or a satellite transmitter for off air transmission. However, it is noted that using transmitter as a television cable or satellite transmitter is well known in the art. Therefore official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Yamamura by using the transmitter of Yamamura as a television cable or satellite transmitter for transmitting the video transmission.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 TECH CENTER ccccustomer service whose telephone number is (703) 306-0377.


HUY NGUYEN
PRIMARY EXAMINER

H.N

January 28, 2003